

U.S. Patent Application Serial No. 09/892,457

REMARKS

Claims 1, 2, 4-9 are pending in this application. Reconsideration of the rejections in view of these amendments and the following remarks is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with Markings to Show Changes Made."

(1) Claim Rejections - 35 U.S.C. 112

Claims 1-9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is respectfully submitted that the amendments of "resol-type phenol resin composition" into "resol resin composition" overcome the rejection under 35 U.S.C. 112, second paragraph.

(2) Claim Rejections - 35 U.S.C. 102(b)

(i) Claims 1-9 were rejected under 35 U.S.C. 102(b) as being anticipated by Gerber (U.S. 5,294,649).

Claim 1 is amended to incorporate the recitation of claim 3, and claim 3 is canceled.

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Contrary to the examiner's statement that all elements are disclosed in the Gerber reference, the specific compound of "ammonium thiosulfate" is not disclosed in Gerber, so the rejection is unsupported by the art and should be withdrawn.

(ii) The examiner rejects claims 1-3 and 7-9 under 35 U.S.C. 102(b) as being anticipated by Engen et al. (U.S. 5,551,961).

Contrary to the examiner's statement that it is clear that Engen et al. anticipate the present claims, the specific composition of amended claim 1 is not disclosed in Engen et al., so the rejection is unsupported by the art and should be withdrawn. Also, the composition disclosed in Engen et al. uses AlCl_3 (Col. 12, lines 14-23), but according to the present invention, AlCl_3 is not used. Therefore, the invention is distinct from Engen et al. also in view of not using AlCl_3 .

(3) Claim Rejections - 35 U.S.C. 103

Claims 1-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. 2,869,194), in view of Meyer (U.S. 4,264,760).

However, Cooper does not disclose ammonium thiosulfate. Meyer discloses specific composition of "ammonium thiosulfate," but ammonium thiosulfate disclosed in Meyer is not used

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in a resol resin composition. Therefore, even if combining Cooper with Meyer, the present invention cannot be obtained.

In addition, one of ordinary skill in the art would not have been motivated to combine the references. There must be a basis in the art for combining or modifying references. The mere fact that the references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination.

Also, prima facie obviousness requires a reasonable expectation of success. The rejection may be based on a presumption that it would be obvious to try ammonium thiosulfate of Meyer in place of the catalyst of Cooper. However, there is no suggestion that the ingredient of Meyer would be tried in place of the catalyst of Cooper. An obvious to try standard is not a proper basis for a rejection under 35 U.S.C. 103.

(4) It is submitted that nothing in the cited references, taken either alone or in combination, teaches or suggests all the features recited in each claim of the present invention. Thus all pending claims are in condition for allowance. Reconsideration of the rejections, withdrawal of the rejections and an early issue of a Notice of Allowance are earnestly solicited.

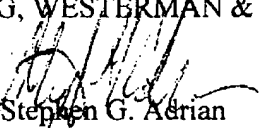
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosures: Version with markings to show changes made

VERSION WITH MARKINGS TO SHOW CHANGES MADE 09/892,457**IN THE CLAIMS:**

Please **CANCEL** claim 3.

Please **AMEND** the claims as follows:

1. (Amended) A resol [-type phenol] resin composition comprising a resol [-type phenol] resin (A), an alkali earth metal oxide and/or an alkali earth metal hydroxide (B), and [~~a salt (C) of a sulfur atom-containing oxo acid and a nitrogen atom-containing base~~] ammonium thiosulfate.

5 4. (Amended) The composition according to claim 1, or 2 [~~or 3~~], wherein the alkali earth metal oxide and/or the alkali earth metal hydroxide (B) are a powder and/or a granulate.

5. (Amended) The resol [-type phenol] resin composition according to claim 1, or 2 [~~or 3~~], wherein 1 to 10000 parts by weight of the alkali earth metal oxide and/or the alkali earth metal hydroxide (B) and 0.1 to 15 parts by weight of [~~the salt (C) of the sulfur atom-containing oxo acid and the nitrogen atom-containing base~~] ammonium thiosulfate are used based on 100 parts by weight of the resol [-type phenol] resin (A).

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7. (Amended) A method for curing a resol [-type phenol] resin, which comprises curing the resol

15 [-type phenol] resin composition of claim 1 at a temperature of from 10 to 110°C.

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8. (Amended) A method for curing a resol [~~-type phenol~~] resin, which comprises curing the resol [~~-type phenol~~] resin composition of claim 2 at a temperature of from 10 to 110°C.

9. (Amended) A method for curing a resol [~~-type phenol~~] resin, which comprises curing the resol
5 [~~-type phenol~~] resin composition of claim 3 at a temperature of from 10 to 110°C.

CARD NO: 21099

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Patent Number: Issued:
Applicant(s): SAMESHIMA, Kenichi et al.

Papers filed herewith on: 03/06/03

Fees: \$ 110.00
Req. for Ext. of Time

Amendment



COMMISSIONER OF PATENTS

Receipt is hereby acknowledged of the papers filed as indicated
in connection with the above-identified case.

SGA/MT